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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAVIV LAOR

Appeal 2008-0532
Application 09/595,677
Technology Center 3600

Decided: May 20, 2008

Before LINDA E. HORNER, JOSEPH A. FISCHETTI, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-3, 11, and 28-31. Claims 4-10 and 12-27 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We REVERSE.

THE INVENTION

The Appellant's claimed invention is directed to a method and system for distributing and redeeming electronic coupons in a networked environment where the source of the coupons, the consumer, and the vendor are all connected to a common communications channel (Spec. 3). Claim 28, reproduced below, is representative of the subject matter of appeal.

28. A system for managing promotions over a network comprising:
an promotion server;
a retailer's commercial server;
a consumer's client computer;
wherein said advertiser's promotion server; said retailer's commercial server; and said consumer's client computer are operably connected to the Internet, and are structured and programmed so that:

said consumer's client computer can request from said retailer's commercial server a promotion; and

said retailer's commercial server responds to requests from said consumer's client computer for said promotion by automatically obtaining from said promotion server promotion authorization data for said promotion, and said retailer's commercial server determines from said authorization data whether to accept or decline said promotion.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

GERACE

US 5,848,396

Dec. 8, 1998

The following rejections are before us for review¹:

1. Claims 1-3, 11, and 28-31 are rejected under 35 U.S.C. § 102(b) as anticipated by Gerace.

FINDINGS OF FACT

We find the following enumerated findings of fact are supported at least by a preponderance of the evidence²:

1. Gerace discloses determining the psychographic and demographic profile of a user (Col. 2:1-15) in a customized ad system.
2. Gerace discloses that advertisements for display to users are based on the psychographic and demographic profiles of the user to provide targeted marketing (Col. 2:30-35).
3. Gerace discloses that each Ad Package Object has an indicated sponsor ID (Col. 12:7-11).
4. Gerace does not disclose the use of a server generating a script for a website frame having a predetermined signature with an electronic token or coupon that corresponds to that predetermined signature.

¹ We note that the objection to new matter in the Specification made under 35 U.S.C. § 132 (a) has been withdrawn in the Examiner's Answer at page 3.

² See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

PRINCIPLES OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

ANALYSIS

The Appellant argues that the rejection of claim 1 is improper because it fails to disclose the limitation for the commercial server to include “a script for generating a website frame having a predetermined signature, such that an electronic token uniquely corresponds to said predetermined signature” (Br. 12). The Appellant also argues that “[t]his application discloses that a token is an identification of or point to an electronic coupon” (Br. 11).

We agree with the Appellant. We first determine the scope of the term “token” in the claims not solely on the basis of the claim language, but upon giving the claims their broadest reasonable construction in light of the Specification as it would be interpreted by one of ordinary skill in the art. Here, the Specification for example in describing the invention states: “[t]his

invention relates to a method of and system for distributing and redeeming electronic coupons or “tokens” in a computer network environment...”

(Replacement Spec. 2). The Specification in describing the invention also states: “[t]he electronic token may only include the complete body of coupon information, or the electronic token may include data identifying the client and pointing to coupon information...” (Replacement Spec. 7). Giving the claims their broadest reasonable construction in light of the whole Specification as it would be interpreted by one of ordinary skill in the art, the definition of “token” in the claims would be taken to refer to, or relate to a “coupon” in some manner.

Claim 1 includes the phrase “script for generating a website frame having a predetermined signature, such that an electronic token uniquely corresponds to said predetermined signature.” First, we consider this phrase to require that the commercial server be configured to: 1. generate a website frame having a predetermined signature and 2. uniquely correspond to an electronic token with the predetermined signature. Gerace does disclose an indicated “sponsor ID” (FF 3) which may be considered a “predetermined signature.” However, Gerace fails to show an “electronic token” as defined by the Appellant which uniquely corresponds to that “sponsor ID” or “predetermined signature” (FF 4) as claim 1 requires. As Gerace fails to disclose the limitation for “a script for generating a website frame having a predetermined signature, such that an electronic token uniquely corresponds to said predetermined signature,” claim 1 is not anticipated.

For the above reasons we will not sustain the rejection of claim 1. As the rejection of claims 2-3 and 11 fails to cure the deficiency of the rejection of claim 1, we will also not sustain the rejection of these claims, which depend from claim 1.

The Appellant also argues that the rejection of claims 28 and 30 is improper because in Gerace “the user never requests the specific advertisement to be transmitted and displayed to the user” (Br. 10).

We agree with the Appellant. Initially we note that claims 28 and 30 each contain a phrase which states that the promotion server, commercial server, and client computer “[a]re structured and programmed so that...” in describing the invention. This phrase in each of claims 28 and 30 is taken to be a limitation that the system is not just “programmable” but actually specifically “programmed” as claimed.

Claims 28 and 30 require that the “retailer’s commercial server responds to requests from said consumer’s client computer for said promotion.” Gerace in contrast displays advertisements based on psychographic and demographic profiles of the user (FF 1 and 2) and not a “request” from the user’s computer. As such, Gerace fails to anticipate claims 28 and 30.

For the above reasons, we do not sustain the rejections of claims 28 and 30. The rejection of dependent claims 29 and 31 fails to cure the deficiency in the rejection of the independent claims, and we also will not sustain the rejection of these claims.

CONCLUSIONS OF LAW

We conclude that Appellant has shown that the Examiner erred in rejecting claims 1-3, 11, and 28-31 under 35 U.S.C. § 102(b) as being anticipated by Gerace.

DECISION

The Examiner’s rejection of claims 1-3, 11, and 28-31 is reversed.

Appeal 2008-0532
Application 09/595,677

REVERSED

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